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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,983	05/11/1999	D. LEE MANNER	T8463488US	3065

7590 01/10/2003

GOWLING STRATHY & HENDERSON
COMMERCE COURT WEST
SUITE 4900
TORONTO, M5L1J3
CANADA

EXAMINER

CLARKE, SARA SACHIE

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/284,983	MANNER, D. LEE
	Examiner	Art Unit
	Sara Clarke	3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 November 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 19,22 and 27-38 is/are pending in the application.
 - 4a) Of the above claim(s) 37 and 38 is/are withdrawn from consideration.
- 5) Claim(s) 19,22 and 27-33 is/are allowed.
- 6) Claim(s) 34-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some
 - * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s) _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Naples (US 3279900).

For claims 34-36, Naples discloses the invention as claimed including a pad 1 made from a cellulosic pulp and saturated (see the patent claims) with wax. Since the pad is packaged in a container 4, is shipped, and received from a store (see col. 2, lines 58-63), the paraffin is necessarily in a hardened state after the pad 1 is treated with it.

However, to the extent that the product-by-process limitations necessarily distinguish the invention from the prior art, the examiner has noted that the applicant's specification does not set forth that such differences unexpectedly solve some problem in the art nor unexpectedly provide some new result when compared with the applied

art. Accordingly, such differences appear to be a mere matter of design choice. ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP §2113 quoting *In re Thorpe*, et al., 227 USPQ 964, 966 (CAFC 1985))

Allowable Subject Matter

Claims 19, 22, and 27-33 are allowable.

Response to Amendments and Arguments

Applicant argues that the method steps of claims 34-36 result in a different product than that of Naples. Applicant argues as follows:

"By requiring this compression step, the Naples product cannot comprise 'a porous carrier impregnated with a liquefied solid fuel such that the liquefied solid fuel is dispersed throughout the porous carrier.' In particular the compressed state of the cellulose-based material of the Naples product resists absorption of a liquefied solid fuel (such as 'ordinary paraffin wax,' referred to in Naples at column 2, lines 48 and 49) upon application of a liquefied solid fuel to the compressed cellulose based material."

While the examiner has considered Applicant's arguments, the examiner notes that the arguments are not supported by any factual evidence. "The arguments of counsel cannot take the place of evidence in the record." MPEP 716.01(c) citing *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

It is noted that the materials of which the product of Naples is made are inherently porous materials. That these materials somehow lose their inherent porosity

through "pressing step" such that they cannot be impregnated with wax, is a position of counsel not supported by any evidence. Moreover, the arguments ignore the teaching in Maples in column 2, line 32, that the combustible is impregnated into the pad. That the pad is impregnated is a clear indication that the pad is porous.

The product as claimed in claim 34 is a porous carrier impregnated with a solid fuel. Likewise, the products of claims 35 and 36 are the same as that of claim 34 plus details of the cellulose fiber product and the solid fuel. On page 4 of the response, Applicant argues that the claimed process results in a different length of fiber. It is noted that, however, that the length of the fiber is not a claimed product feature. See MPEP 2145(VI). Moreover, once again, Applicant has not provided any evidence in support of his conclusion.

Applicant further argues that the claimed invention has a different use versus that of the Naples product. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this or earlier communications from the examiner should be directed to Sara Clarke whose telephone number is (703) 308-1388. The examiner can normally be reached on M-Thurs, 8:30-5:00, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application is assigned are (703) 305-3463 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0861.


Sara Clarke
Primary Examiner
Art Unit 3743

January 9, 2003